

Via E-FILE

PATENT APPLICATION
Docket No. 13768.132

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of)
)
	Damon Barry, et al.)
)
Serial No.:	09/607,397) Art Unit
) 2192
Filed:	June 30, 2000)
)
Conf. No.:	9886)
)
For:	SYSTEMS AND METHODS FOR GATHERING)
	ORGANIZING AND EXECUTING TEXT CASES)
)
Examiner:	Eric B. Kiss)
)
Customer No.:	47973)

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Mail Stop **APPEAL BRIEF-PATENTS**
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

In reply to the Final Office Action mailed August 15, 2006 ("Office Action"), and pursuant to the July 12, 2005, OG Notice regarding the Pre-Appeal Brief Conference Pilot Program, and the February 7, 2006 OG Notice extending the program, Applicants respectfully request panel review and allowance of the rejected claims in light of the Examiner's errors discussed below. No amendments are being filed with this Request. This Request is being filed concurrently with a Notice of Appeal. Claims 1-4, 7, 10-17, and 20-28 remain pending in this application.

Applicants may request a pre-appeal brief review of rejections set forth in an Office Action if (1) the application has been at least twice rejected; (2) Applicant concurrently files the Request with a Notice of Appeal and prior to an Appeal Brief; and (3) Applicant submits a Pre-Appeal Brief Request for Review that is five (5) or less pages in length and sets forth legal or factual deficiencies in the rejections. See Official Gazette Notice, July 12, 2005. Applicants have met each of these requirements and therefore request review of the Examiner's rejections in the Final Office Action for the following reasons.

In the Final Office Action, mailed August 15, 2006, claims 1, 2, 4, and 7-28 were rejected under 35 U.S.C. 102(b) as being anticipated by the TETware Release 3.3 software product released September 18, 1998 by The Open Group, as evidenced by: "TETware User Guide, Revision 1.2", "Release Notes for TETware Release 3.3" and "TETware Programmers Guide, Revision 1.2"; and claim 3 was rejected under 35 U.S.C. 103(a) as being unpatentable over TETware and the associated cited documentation as applied to claim 1 above, and further in view of Hartmann et al. (U.S. Patent No. 6,505,342).

The Examiner erred in applying the TETware references in the rejection of claims 1, 2, 4, and 7-27 for at least the reason that TETware fails to disclose or suggest each and every element of the claimed invention. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." MPEP § 2131. That is, "for anticipation under 35 U.S.C. 102, the reference must teach every aspect of the claimed invention either explicitly or impliedly." MPEP § 706.02.

In this case, not only does TETware not disclose each and every element of the claimed invention, TETware specifically teach how they do not contain all of the claim limitations of the rejected claims. For example, each of independent claims 1, 4, 15, and 24 include the recitation

of a “test hierarchy in which one or more test cases comprise a test suite, and in which one or more test suites comprise a test module.” The Examiner alleges that “TETware [discloses] one or more test cases comprising a test suite in the hierarchy and one or more test suites comprising a test module in the hierarchy,” citing section 2.2 of TETware User Guide, 4.1 of TETware Programmers Guide, and 5.3.2.1 of TETware User Guide. Office Action at 4. However, a careful review of the TETware literature reveals that the cited sections simply *do not* disclose or suggest a “test hierarchy in which one or more test cases comprise a test suite, *and in which one or more test suites comprise a test module*,” as recited in independent claims 1, 4, 15, and 24. (Emphasis added).

The relevant portions of the cited portions of the TETware documentation are recited below to highlight the Examiner’s error in interpreting the reference. “**A test suite is the largest grouping** of tests that can be processed by the TETware Test Case Controller. **A test suite is made up of one or more test cases. A test case is the smallest test program unit** that can be built or cleaned up by the Test Case Controller.” TETware User Guide § 2.2 (emphasis added). “The scenario file contains one or more test scenarios for a test suite... A scenario file should contain (at least) a scenario named “all”; by convention, this causes **all the test cases in the test suite** to be processed.” TETware User Guide § 5.3.2.1 (emphasis added). “When the tcc processes test cases, it does so by reading instructions contained in a test scenario. Each test suite should include a scenario file which contains one or more test scenarios.” TETware Programmers Guide § 4.2.

It appears that the Examiner’s error is rooted in his confusing the test scenario as having a hierarchical position in TETware. As the cited portions above make clear, the scenario is merely a set of instructions within the test suite to determine which of the test cases in the test suite to

run. Instructions are not “tests” and do not occupy any hierarchical position between, above, or below the test case or the test suite. Instructions simply aid in determining which test cases in the test suite are applied to a particular situation, and, thus, do not occupy any hierarchical position in TETware. Section 2.2 of the User Guide is abundantly clear in the hierarchical organization of TETware, completely contradicting and proving erroneous the Examiner’s application of TETware as disclosing the claimed elements. **“A test suite is the largest grouping of tests that can be processed by the TETware Test Case Controller. A test suite is made up of one or more test cases. A test case is the smallest test program unit that can be built or cleaned up by the Test Case Controller.”** TETware User Guide § 2.2 (emphasis added).

As discussed, TETware simply does not disclose or suggest a “test hierarchy in which one or more test cases comprise a test suite, and in which one or more test suites comprise a test module,” as recited in each of independent claims 1, 4, 15, and 24. As such, the Examiner erred in alleging that TETware anticipates each and every element of the claimed invention, as required by the M.P.E.P. At least for this error by the Examiner, and because each of claims 2, 7-14, 16-23, and 25-28 depend from one of claims 1, 4, 15, and 24, and include all limitations of the claims from which they depend, the rejection of claims 1, 2, 4, and 7-27 under 35 U.S.C. § 102(b) as being anticipated by TETware should be withdrawn.

With respect to the rejection of claim 3 under 35 U.S.C. § 103(a) as being unpatentable over TETware in view of U.S. Patent No. 6,505,342 to Hartman et al., the Examiner applies the reasoning of the rejection of claim 1 under 35 U.S.C. § 102(b) to the rejection under 35 U.S.C. § 103(a). See Office Action at 10. The Examiner erred in rejecting claim 3 for at least the same reasons as discussed above. Therefore, the rejection of claim 3 should also be withdrawn for the same reasons.

Applicants request reconsideration of the application and withdrawal of the rejections discussed above by the reviewing Panel. Applicants submit that the application is in condition for allowance. In the event that the Examiner or Panel find any remaining impediment to a prompt allowance of this application that may be clarified through a telephone interview, the Examiner or Panel is requested to contact the undersigned attorney for any clarification or discussion that may be necessary.

Dated this 15th day of September, 2006.

Respectfully submitted,

WORKMAN NYDEGGER

/F. Chad Copier/
RICK D. NYDEGGER
Registration No. 28,651
ADRIAN J. LEE
Registration No. 42,785
F. CHAD COPIER
Registration No. 54,047
Customer No. 047973
Attorneys for Applicant

FCC:jbh
FCC000000018V001